

Application Serial No. 10/715,026
Reply to office action of December 1, 2005

PATENT
Docket: CU-4112

REMARKS/ARGUMENTS

Reconsideration is respectfully requested.

Claims 1-6 are pending before the present amendment. By the present amendment, claim 5 has been cancelled without prejudice; claims 1-4 and 6 have been amended; and claims 7-8 have been added. No new matter has been added.

In the office action, the claims stand objected to for containing reference numerals not enclosed in parentheses. In response, all reference numerals have been deleted from the claims.

In the office action, claims 1-6 stand rejected under 35 U.S.C. §112, ¶2, as being indefinite. In response, all appropriate corrections have been made, and withdrawal of the rejections is respectfully requested.

In the office action, claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,634,444 (Coleman). Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,934,779 (Wollner).

In the office action, claims 5-6 are indicated as being allowable if they are rewritten in independent form to include the limitations of all intervening and base claims.

In response, claim 1 has been amended to incorporate the limitations of the allowable claim 5; and claim 5 has been cancelled. At least for this reason, claims 1-4 are now in condition for allowance.

Further, the allowable claim 6 has been amended to incorporate the limitations of the base claim 6; and claims 7-8 have been added. The amendments to claims 6-8 are fully supported in the specification page 9-10 and FIG. 6. At least for this reason, claims

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6-8 are in condition for allowance.

Accordingly, issuance of a **Notice of Allowance** for claims 1-4 and 6-8, now pending in this application, is respectfully requested in the next action.

Finally, the applicant respectfully notes just for the examiner's reference the following rule on functional limitations (such as "being capable of") in a claim.

MPEP §2173.05(g) makes it very clear that:

"There is **nothing inherently wrong** with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)."

In fact, the same section of MPEP **requires** that the functional claims should be treated as and be examined "just like any other limitation of the claim":

"A functional limitation **must** be evaluated and considered, **just like any other limitation** of the claim, for what it fairly conveys to a person of ordinary skill in the art in the context in which it is used." MPEP §2173.05(g).

The Court in *In re Venezia*, 189 USPQ 149, has held that a limitation that is **capable of** performing a function is an acceptable recitation.

"In a claim that was directed to a kit of component parts **capable of being assembled**, the Court held that limitations such as 'members adapted to be positioned' and 'portions ... being resiliently dilatable whereby said housing may be slidably positioned' serve to **precisely define present structural attributes** of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)." MPEP §2173.05(g).

In fact, the experience of the attorney of record of the present application in prosecuting patent claims in the past with the USPTO in general has been that the functional limitations containing the term "**capable of**" has always been considered a definite and non-negative limitation and has always been included in the subject matter of the substantive examination.

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This amendment is considered to be responsive to all points raised in the office action. Should the examiner have any remaining questions or concerns, the examiner is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,



Dated: February 22, 2006

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